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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,842	09/05/2006	Peter Hupfield	DC10005 PCT1	3322
137 7590 07/09/2008 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER				
BUIE, NICOLE M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary

Application No.

10/591,842

Applicant(s)

HUPFIELD, PETER

Examiner

NICOLE M. BUJE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 20060905

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westall et al. (WO 03/016380) in the view of Morita et al. (US 6,641,805).

Regarding claims 1, 9, 10, 11, and 12, Westall et al. discloses a composition comprising an aminosiloxane containing amino groups substituted by an olefinically unsaturated group (The aminosiloxane can be reacted with an acrylate or other activated C=C bond...) [0027].

However, Westall does not disclose a fluoro-substituted alkyl ester. Morita et al. teaches fluorine-containing (meth)acrylates (C3/L1-27, C4/L14-41) and a silicon-containing polymerizable compound (C8/L28-37). Morita et al. further discloses the composition wherein the reaction product contains 5 to 95% by weight of the aminosiloxane (as compared to 0.1 to 95% by weight as required by said claim, C8/L41-48) and 5 to 95% by weight of the fluoro-substituted alkyl ester (as compared to 5 to 95% as required by said claim, C8/L28-37). Westall and Morita et al. are analogous art concerned with cosmetics comprising aminosiloxanes. It would have been obvious to one of ordinary skill in the art at the time of invention to add the fluorine-containing (meth)acrylates of Westall in the composition of Westall et al. and the

motivation to do so would have been as Morita et al. suggests, to improve the waterproofing property and the water- and oil-repellency to films (C1/L7-15).

Regarding claim 5, Westall et al. discloses the aminosiloxane is also substituted by an organic moiety which has no ethylenic unsaturation (an aliphatic group is attached to the silicon backbone) [00202].

Regarding claim 6, Westall et al. discloses the amino groups of the aminosiloxane are unsubstituted amino alkyl groups of the formulas $R-(NH-A')-NH-A-$ attached to silicon, wherein A and A' are each independently a linear or branched alkylene group having 1 to 6 carbon atoms; $q=0-4$ and R is hydrogen or an alkyl or hydroxyalkyl group having 1 to 4 carbon atoms [0009].

Regarding claim 7, Westall et al. discloses the aminosiloxane is a polyorganosiloxane having pendent aminoalkyl groups [00202].

Regarding claim 8, Westall et al. discloses the aminosiloxane also contains amino groups modified by reaction with a lactone or epoxide [0027].

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westall et al. (WO 03/016380) in the view of Morita et al. (US 6,641,805) as applied to claim 1 above, in further view Blizzard et al. (US 5,739,192).

Regarding claims 2-4, modified Westall et al. discloses the composition as shown above in claim 1.

Regarding claims 2-4, modified Westall et al. does not disclose the olefinically unsaturated group of the aminosiloxane is an acrylate or methacrylate ester group. Blizzard et al.

teaches a Michael Addition reaction between polysiloxanes containing amine functional groups and acrylates having hydrocarbon containing groups (C1/L6-10). Blizzard et al. further discloses the acrylate can be multifunctional, such as ethylene glycol diacrylate, diethylene glycol diacrylate, tetraethylene glycol diacrylate, tripropylene glycol diacrylate (C3/L25-45). Modified Westall et al. and Blizzard et al. are analogous art concerned with aminosiloxanes. It would have been obvious to one of ordinary skill in the art to use the acrylates of Blizzard et al. in the substitution of the amino groups of the aminosiloxane of modified Westall et al. and the motivation to do so would have been as Blizzard et al. suggests, to add functionality to the aminosiloxane (C1/L13-24).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Westall et al. (WO 03/016380) in the view of Morita et al. (US 6,641,805) as applied to claim 1 above.

Regarding claim 13, Modified Westall et al. discloses the composition as shown above in claim 1. Westall et al. further discloses the composition of the aminosiloxane can be used in the textile industry as fiber lubricants, such as polyester, polyamide, acrylic, cotton or wool fibers [0025].

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARK EASHOO, PhD./
Supervisory Patent Examiner, Art Unit 1796
6-Jul-08

/N. M. B./
Examiner, Art Unit 1796
7/2/2008